



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,553	09/06/2003	Oscar D. Sandlin		8187

7590 11/22/2005

John V. Moriarty
Woodard, Emhardt, Moriarty, McNett & Henry LLP
Bank One Tower
111 Monument Circle Suite 3700
Indianapolis, IN 46204

EXAMINER

COSTALES, SHRUTI S

ART UNIT	PAPER NUMBER
----------	--------------

1714

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Application No.

10/656,553

Applicant(s)

SANDLIN ET AL.

Examiner

Shruti S. Costales

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. All outstanding objections and rejections except for those described below are overcome by applicant's amendment filed August 15, 2005.
2. Applicant's amendment and 37 C.F.R. § 1.131 declarations filed August 15, 2005 were not persuasive in overcoming the rejections of record, accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
4. Claims 1-11, 13-14, and 16-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. (U.S. Patent Number 6,706,107) in view of the evidence set forth by Immordino, JR. et al. (U.S. Pre-Grant Publication Number 2002/0129744).

The rejection is adequately set forth in paragraph 9 of the office action mailed April 25, 2005 and is herein incorporated by reference.

5. Claims 1 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Maleeny et al. (U.S. Pre-Grant Publication Number 2003/0232901) in view of the evidence set forth by Takarabe et al. (U.S. Patent Number 5,705,560).

The rejection is adequately set forth in paragraph 10 of the office action mailed April 25, 2005 and is herein incorporated by reference.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

7. Claims 1 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Maleeny.

The rejection is adequately set forth in paragraph 12 of the office action mailed April 25, 2005 and is herein incorporated by reference.

8. Claims 1-11, 13-14, and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maleeny in view of Takarabe and Walker.

The rejection is adequately set forth in paragraph 13 of the office action mailed April 25, 2005 and is herein incorporated by reference.

9. Claims 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maleeny in view of Engle (U.S. Patent Number 4,095,031).

The rejection is adequately set forth in paragraph 14 of the office action mailed April 25, 2005 and is herein incorporated by reference.

10. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maleeny in view of Engle and Walker.

The rejection is adequately set forth in paragraph 15 of the office action mailed April 25, 2005 and is herein incorporated by reference.

11. Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Maleeny, Engle, and Sokol (U.S. Patent Number 6,583,195).

The rejection is adequately set forth in paragraph 16 of the office action mailed April 25, 2005 and is herein incorporated by reference.

12. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Donovan (U.S. Patent Number 5,217,378).

The rejection is adequately set forth in paragraph 17 of the office action mailed April 25, 2005 and is herein incorporated by reference.

Response to Arguments

13. Applicant's amendments to the claims, arguments and three declarations filed on August 15, 2005 have been fully considered but they are unpersuasive. It is to be noted that although the applicant does not identify the declarations filed on August 15, 2005 as 37 C.F.R. § 1.131 declarations, the Examiner has considered said declarations as 37 C.F.R. § 1.131 declarations as the applicant is attempting to establish a reduction to practice date prior to the filing dates of the Walker and Maleeny references.

Specifically, with respect to the 37 C.F.R. § 1.131 declarations, the applicant has filed three declarations, the first by Bill Oltman (one of the inventors of the present invention), the second by Brian Irwin (a maintenance supervisor), and the third by Beverly Rahe (a leasing agent).

The first declaration, hereinafter referred to as the Oltman declaration, is not effective because the method of making the paint composition with a potpourri scent tested in April 2001 in the Oltman declaration is not the same as the method of making a long-lasting paint as presently claimed. For example, the presently claimed method of claim 1 includes mixing or agitating the paint components to form a dispersion, wherein no such dispersion was formed in the Oltman declaration. Further, the present claims also include the embodiment wherein the scenting agent is directly added onto a surface before the paint dries. The Oltman declaration does not describe any such embodiment. The Oltman declaration further fails to provide any evidence to support the allegations set forth, i.e., lab notebooks, etc. Moreover, in paragraph 11 of the Oltman declaration, it is stated that experimentation was continued to develop various scents and to increase the lasting effect of the scent. It is therefore not clear to the Examiner if the present claims are drawn to the methods that were developed from further experimentation, i.e., having a reduction to practice date after April 2001. Further, it is not clear if paint with a potpourri scent in paragraph 6 of the Oltman declaration is the same as the long-lasting paint of the present claims as there is no mention of "potpourri" in the present claims.

The second and third declarations, hereinafter referred to as the Irwin and Rahe declarations, are not persuasive because it is not clear whether the "scented paint" referred to in the Irwin and Rahe declarations is the same as the long-lasting scented paint of the present claims. Furthermore, the Irwin and Rahe declarations include statements that Irwin and Rahe are not aware of how the "scented paint" was made. It is to be further noted that the present claims are drawn to methods of making a long-lasting scented paint, wherein the Irwin and Rahe declarations do not address the claimed methods in any way.

It is therefore the Examiner's position that the three 37 C.F.R. § 1.131 declarations filed by the applicant on August 15, 2005 are ineffective to overcome the Walker and Maleeny references. Consequently, the rejections set forth above in paragraphs 3-12 are maintained.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1714

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shruti S. Costales whose telephone number is (571) 272-8389. The examiner can normally be reached on Monday - Friday, 6:30 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SSC
Shruti S. Costales
November 18, 2005

Vasu Jagannathan
VASU JAGANNATHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700